

REMARKS

A Petition for Extension of Time is being concurrently filed with this Reply. Also, the due date of March 25, 2006, falls on a Saturday. Thus, this Reply is being timely filed.

Applicants respectfully request the Examiner to reconsider the present application in view of the foregoing remarks. An Information Disclosure Statement is being filed concurrently to submit for consideration by the Examiner an English language translation of the cited JP 11-254656 reference. The Examiner is respectfully requested to return an initialed copy of the Form SB08 to the offices of the undersigned.

Status of the Claims

No claims are being amended, canceled or added. Thus, a listing of the pending claims is not necessary.

Claims 2, 3, 8 and 22-28 are pending in the present application.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw the remaining rejections and allow the currently pending claims.

Issues Under 35 U.S.C. § 102(b) and § 103(a)

Claims 2, 3, 8 and 22-28 stand rejected under 35 U.S.C. § 102(b) as being anticipated by, or in the alternative under 103(a) over JP '656 (JP 11-254656; computer translation) (see paragraphs 4-5 at pages 2-5 of the outstanding Office Action). Applicants respectfully traverse, and reconsideration and withdrawal of these rejections are respectfully requested.

Though Applicants have previously argued that the present invention does not have its adhesive layer as a foamed layer as disclosed in JP '656, the Examiner forms the anticipatory and obviousness rejections for the reasons stated in paragraphs 4 and 5 (the previous rejection was cited under § 103(a)). In particular, and in part, the Examiner is referring to parts of JP '656 to match those ingredients used in the present invention. However, to clarify Applicants' position, Applicants have obtained and now herein enclose an English language translation of the cited JP 11-254656 reference. One of ordinary skill in the art would understand that JP '656 fails to disclose all instantly claimed features.

As can be seen from paragraph [0012] of JP '656, this cited reference discloses:

The cleaning sheet of the present invention can be manufactured by using a conventional foaming forming method, for example, an extrusion foaming forming method and an ejection foaming forming method or the like. After a mixed solution containing the resin constituting the foam layer 3 and a suitable foaming agent is applied on the base material 2, the cleaning sheet can be also manufactured by heating and foaming the mixed solution. A foaming method can be suitably selected according to the kind of the resin, any method such as a method (mechanical foaming method) for forming the resin by mechanical stirring, a method for using reaction generation gas, a method for using a foaming agent (a volatile foaming agent or a degradable foaming agent), a method for removing a soluble substance, a method for foaming by a spray, a method for forming a syntactic foam, and a sintering method may be used.

According to this description in paragraph [0012], JP '656 describes that it is necessary to force a resin composition layer to form foam by using a conventional foaming forming method when manufacturing the foaming layer of JP '656. On the other hand, the present invention utilizes an adhesive layer wherein this forced foaming forming method is not used. This leads to structural distinctions.

The “solid” adhesive layer of the present invention occasionally includes fine foam formed in the step of forming this layer. But this means that the present adhesive layer is structurally different from the foam layer of the JP ‘656 embodiment. Thus, there is a difference in having “fine foam” present in the claimed “solid” adhesive layer of the present invention versus the foam/foamed layer in the JP ‘656 embodiment.

Applicants note that each structure of the claimed pressure-sensitive adhesive sheets versus the corresponding structures of the JP ‘656 embodiment brings about or contributes to the cleaning mechanism thereof. Namely, the cited JP ‘656 embodiment utilizes adsorption to the rough surface of the foam layer. Applicants herein enclose the *Webster’s Dictionary* (1979) definition of “adsorption”. However, the present invention utilizes absorption, wherein the instantly claimed sheet absorbs the ink on an article (in a short time) (see, e.g., page 9 of the present specification; see also the Rule 132 Declaration filed on August 18, 2005). A further advantage of the present invention is how there is no transfer of the adhesive layer component onto the article even after the solvent absorption.

Based on the differences in structure and how each cleans, the present invention is structurally, patentably distinct from the embodiment of the JP ‘656 reference. Because “a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference,” the cited JP ‘656 reference cannot be a basis for a rejection under § 102(b). See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Thus, because of the lack of disclosure of all features as instantly claimed, the rejection in view of JP ‘656 is overcome. Applicants further note that anticipation is not established if it is necessary to pick, choose and combine various

portions of the disclosure, not directly related to each other by teachings of a reference (e.g., JP '656), in order to find that anticipation claim reads on that reference. Thus, reconsideration and withdrawal of this rejection under § 102(b) are respectfully requested.

Applicants also maintain there is no disclosure of the claimed features of, e.g., "wherein the pressure-sensitive adhesive sheet after absorbing 5g/m^2 of the solvent has a tackiness of 3 cN/25-mm or more as determined by a method in conformity with Japanese Industrial Standards (JIS) Z 0237" as recited in pending claim 5. Applicants note that the structural distinctions pointed out above lead to such solvent absorption (not adsorption) properties.

With regard to the rejection under § 103(a), a *prima facie* case of obviousness has not been established since there is no disclosure of all claimed features as explained above. *See In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). Applicants also maintain their position of patentability as stated in the August 18, 2005 Amendment (which is herein incorporated by reference).

Applicants note that there exists the additional patentable distinction of unexpected results as achieved by the present invention (with regard to the current rejection is under § 103(a)). As shown in the previously filed Rule 132 Declaration (filed August 18, 2005), the efficiency of removal of a solvent-containing substance of a pressure-sensitive adhesive sheet of the present invention (Example A in the Declaration) is obviously superior to that of the JP '656 sheet (which is represented as Example B in the same Declaration) (see also page 16 of Applicants' August 18 Amendment After Final). Applicants note that the mentioned comparative showing need not compare the claimed invention with all of the cited prior art, but only with the closest prior art. *See* M.P.E.P. §§ 716.02(b) and 716.02(e); *see also In re Fenn et*

al., 208 USPQ 470 (CCPA 1981). Accordingly, JP '656 fails to disclose such unexpected advantages as achieved by the present invention and the rejection under § 103(a) has been overcome for this additional reason.

Thus, Applicants respectfully submit that JP '656 fails to disclose all claimed features and that these rejections have been overcome. Reconsideration and withdrawal thereof are respectfully requested.

Previously-filed Information Disclosure Statement

Applicants filed an Information Disclosure Statement (IDS) on September 26, 2003. However, Applicants have not received a copy of the PTO-1449 form having the Examiner's initials next to the cited reference of JP 10-180991. If a copy of this IDS/PTO-1449 cannot be found, Applicants respectfully request that the Examiner contact Applicants' representative at the contact information given below.

Conclusion

A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez (Reg. No. 48,501) at the telephone number of the undersigned below.

Application No. 09/936,930

Docket No.: 3273-0146P

Art Unit 1771

Reply to Office Action of October 25, 2005

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: Monday, March 27, 2006

Respectfully submitted,

By 

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Attachments:

- *Webster's New Twentieth Century Dictionary* (1979) definition of "adsorption"
- Information Disclosure Statement submitting English language translation of JP 11-254656